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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,883	05/24/2006	Peter Dahmen	2400.0180000/RWE/L-Z	8057
26111 7590 01/06/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER HOLLOMAN, NANNETTE				
ART UNIT		PAPER NUMBER		
1612				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/565,883	Applicant(s) DAHMEN ET AL.
Examiner NANNETTE HOLLOMAN	Art Unit 1612

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 9 and 10.
Claim(s) withdrawn from consideration: 3-5 and 8.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached *Information Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 2009/11/18
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/NANNETTE HOLLOMAN/
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1, 9 and 10 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the inventions. These rejections are maintained.

First paragraph

Applicant's Arguments: Applicant argues even though the specification or the claims as originally filed did not use the phrase "consisting essentially of" literally in describing the claimed invention, one of ordinary skill in the art would reasonably conclude that Applicants were in possession of the invention as now claimed at the time of filing at least because Applicants described an exemplary composition containing three active compounds. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: Applicant has not shown what it regarded as constituting a material change in the basic and novel characteristics of the claimed composition. Since there appears to be no disclosure of "consisting essentially of" or any disclosure of what material would change the basic and novel characteristics of the claimed composition the phrase "consisting essentially of" is "new matter". Applicant does not provide guidance as to how to determine what components would be excluded. An example only shows a preferred embodiment and does not provide guidance. In regard to Applicant's example, some extenders and/or surfactants materially affect the performance of active compounds; therefore it can not be determined by the claims or the example which extenders and/or surfactants do and do not affect the composition.

Second paragraph

Applicant's Arguments: Applicant argues one of ordinary skill in the art would know whether a given ingredient in a fungicidal composition is an active compound or a formulation aid. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: The limitation of optionally including extenders and/or surfactants renders the claims indefinite, since it is not clear what materials change the basic and novel characteristics of the composition.

Claims 1 and 9-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dutzmann et al. (US Patent No. 6,306,850). This rejection is maintained.

Applicant's Arguments: Applicant argues Dutzmann does not disclose the specific three-compound composition containing fluoxastrobin, prothioconazole and tebuconazole and is silent to the ratio of fluoxastrobin to tebuconazole. Applicant further argues synergistic effects, comparing different fungus and different test conditions. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: In regard to the three-compound composition and the ratio of fluoxastrobin to tebuconazole, as previously asserted, the reference discloses the combination of prothioconazole with at least one other active compound, therefore a combination of more than one active compound would be obvious. The reference discloses the ratio of prothioconazole to fluoxastrobin and prothioconazole to tebuconazole; which would lead one of ordinary skill to the ratio of fluoxastrobin to tebuconazole of 0.1:0.1 to 50:20.

Examiner notes the typographical errors in the Dutzmann patent; however applicant's claim to unexpected results does not appear to be supported. As Applicant disclosed, Table 7 of Dutzmann did not give 100% efficacy for prothioconazole alone; however, when looking to the International Publication, WO 98/47367 (as disclosed by applicant) at p. 51, Table 7, the ratio of prothioconazole to fluoxastrobin is 1:3 and the efficacy of the combination is 100%. Adding a third composition could not give anymore than the 100% received. As previously asserted, comparing the results in the Table on page 9 of the instant specification to the results in Table 5, column 37 of Dutzmann, the results for Dutzmann of the combination of prothioconazole and tebuconazole at a ratio of 1:1 and 1:3 resulted in an efficacy of 100%, furthermore adding a third composition could not give anymore than the 100% received, therefore there appears to be no support for synergism or unexpected results.

In regard to different fungus and different test results, there appears to be no comparison of different fungus species and Applicant has not shown that the slight difference in test conditions, i.e. 1 day, would have any impact on the results.

As previously asserted, assuming, purely arguendo, that unexpected results had been shown, Applicant's claims encompass a broader range than that shown in the Table on p. 9 of the instant specification and Tables 1 and 2 of the declaration filed June 3, 2009, therefore the examples are not commensurate in scope with the instant claims.